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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/920,404	08/02/2001	Berardino Salvatore	GB9-2000-0088-US1	5864

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IBM Corp
IP Law
11400 Burnett Road, Zip 4054
Austin, TX 78758

EXAMINER

HAILU, TADESSE

ART UNIT PAPER NUMBER

2173

DATE MAILED: 12/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/920,404

Applicant(s)

BERARDINO SALVATORE

Examiner

Tadesse Hailu

Art Unit

2173

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 6-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 6-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 8/2/01 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4, 5.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This Office Action is in response to the AMENDMENT entered on July 7, 2004 for the patent application (09/920,404) filed on August 2, 2001.

Priority

2. The present patent application claims priority from Foreign (GB) Application No. 0104760.4 filed February 24, 2001.

Status of the claims

3. The pending claims 1, and 6-24 are examined herein as follows:

Specification

4. The corrections made to the title of the invention and the Abstract on 7/7/2004 are considered and entered into the file.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, and 6-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Tanaka (US 5,249,296).

The present invention is directed to positioning a new window on the desktop, wherein before opening a new window, a user can select an area on the desktop

where the window will be displayed, so that the user can decide which windows or portion of windows must be visible after the new window is displayed on the desktop.

Tanaka is also directed to do the same (abstract, column 6, lines 1-12).

With regard to claim 1:

Tanaka discloses a computer system (Fig. 2) having a graphic user interface (e.g. Fig. 8) for displaying a plurality of objects on a desktop (e.g. Fig. 8), a method for controlling the displaying of new objects (e.g. Figs. 8 and 9, K) on the desktop includes the steps of detecting a user request for displaying a new object on the desktop (Fig. 7, column 5, lines 29-68);

the method also includes responsive to user selection (Fig. 7, column 5, Lines 29-68), determining a target area (e.g. Figs. 8 and 9, K (outline window)) on the desktop;

the method also includes responsive to user selection (see Fig. 8, K), determining a target area on the desktop (Fig. 8), the user selection including selecting a first corner (see Fig. 8, K) of the target area by placing a pointing device to a first location (see Fig. 8, K) on the desktop and dragging the pointing device from the selected first location to a second location on the desktop (see Fig. 9, K, and column 6, lines 1-12), the second location being a second corner of the target area (see K in Fig. 9, also see the steps in Fig. 7, column 5, Lines 29-68, column 6, lines 1-12); and

the method further includes displaying the new object within the target area (e.g. Figs. 8 and 9, K column 6, lines 1-12).

With regard to claims 6, 11, and 14:

Independent claims 6, 11, and 14 corresponds generally to independent claim 1 and recites similar features in apparatus, program-product (storage medium form), and system form, respectively, therefore are rejected under the same rationale.

With regard to claim 9:

As illustrated in Figs. 8 and 9 and as described in column 5, lines 29-column 6, lines 30, said second corner of Tanaka is diagonally opposite the first corner.

With regard to claims 7, 12, and 15:

These claims are rejected for reasons similar to those given for the rejection of claim 9.

With regard to claim 10:

Tanaka further describes the target area (Fig. 9, K) includes a top and bottom left corners and a top and bottom right corners (i.e. rectangular area K), the first corner being the top left corner of the target area (see the coordinate values illustrated in Figs. 3 and 7, also see column 5, lines 29-68, column 6, lines 1-30).

With regard to claims 8, 13, and 16:

These claims are rejected for reasons similar to those given for the rejection of claim 10.

With regard to claim 17:

Tanaka discloses a method of positioning and sizing/resizing a window (Figs. 8 and 9) on a GUI includes at least the steps of determining a target area on the GUI where to open the window (column 5, lines 29-column 6, lines 30), the step of determining includes at least enabling a user to select a first corner (column 6, lines 1-12, Fig. 8) of the target area by placing a pointing device (Fig. 2, #1, column 5, Lines

29-68) to a first location (see Fig. 8, K) on the desktop and dragging the pointing device from the selected first location to a second location on the desktop (see Fig. 9, K, and column 6, lines 1-12), the second location being a second corner of the target area (see K in Fig. 9, also column 5, lines 29-column 6, lines 30); and

The method also includes at least enabling the user to open the window on the GUI (column 6, lines 1-30, Fig. 9).

With regard to claim 18:

As illustrated in Figs. 8 and 9 and as described in column 5, lines 29-column 6, lines 30, said second corner of Tanaka is diagonally opposite the first corner.

With regard to claims 19, 21, and 23:

Independent claims 19, 21, and 23 corresponds generally to independent claim 17 and recites similar features in apparatus, program-product (storage medium form), and system form, respectively, therefore are rejected under the same rationale.

With regard to claims 20, 22, and 24:

These claims are rejected for reasons similar to those given for the rejection of claim 18.

Response to Arguments

6. Applicant's arguments filed July 7, 2004 have been fully considered but they are not persuasive. Applicant argues that Tanaka does not teach, show or suggest positioning and **sizing** a window on a GUI as claimed. The Examiner disagrees. When analyzing Tanaka's teaching, the Applicant also states, "As the user continues to drag the pen, the outline of **the window will change position.**" (Page 13) Applicant also

states Tanaka merely teaches positioning a window on a GUI; the size of the window is however **preset** (page 14) (emphasis added). As stated above by the Applicant, the applicant's position is not clear, Applicant has a contradicting view analyzing Tanaka. As illustrated in Figs. 8 and 9 while an outline of a window is repositioning (via dragging) it is also changing the size of the outline window.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

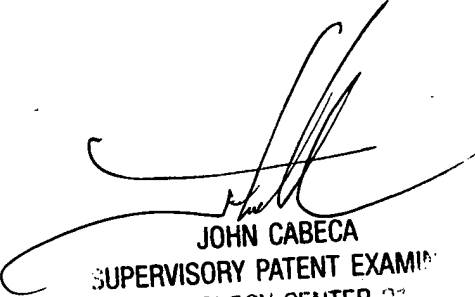
8. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Tadesse Hailu, whose telephone number is (571) 273-4051. The Examiner can normally be reached on M-F from 10:00 - 630 ET. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, John Cabeca, can be reached at (571) 273-4048 Art Unit 2173.

Art Unit: 2173

9. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Tadesse Hailu

11/23/04



JOHN CABECA
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